

REMARKS

Applicants thank Examiner Toomer for indicating that Claims 8, 20-29, 32-33, 48-50, 52-54 and 76-77 are allowed. Applicants submit herewith a Terminal Disclaimer in view of co-pending application 10/536,401. Applicants submit the amendment to the claims and the filing of the Terminal Disclaimer places all now-pending claims in condition for allowance. The amendment of the present paper cancels claims without surrender of subject matter or disclaimer.

Applicants' submission of a Terminal Disclaimer does not constitute agreement or assent with the Office's determination of obviousness-type double patenting. Moreover, Applicants' submission of a Terminal Disclaimer does not function to estop Applicants from obtaining the full scope of patent protection available for equivalents under the doctrine of equivalents. The Federal Circuit recently reinforced this principle in *Amgen Inc. v. Hoechst Marion Roussel Inc.*, 57 USPQ2d 1449 (D. Mass. 2001) where the court stated:

... Amgen's terminal disclaimer [does not] give rise to estoppel. Amgen filed a terminal disclaimer, causing the term of the '080 patent to end on the same day as the term of the '933 patent, for the purpose of mooted any possible non-statutory, obviousness-type double patenting rejection. ... One might expect that such an attempt to avoid an objection relating to double patenting would be grounds for estoppel. Yet terminal disclaimers do not operate to effect estoppel: the filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection. (Citations omitted). There is no indication in the Federal Circuit's recent *Festo* decision that this limitation to estoppel is no longer good law. Without additional evidence, the Court will not infer from the terminal disclaimer that Amgen sought to overcome a meritorious prior art rejection.

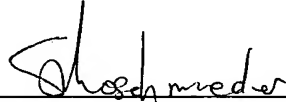
See *Amgen* 1496-1497.

Applicants request the mailing of a Notice of Allowance acknowledging the patentability of the presently claimed subject matter.

The Examiner is invited to contact Applicants' U.S. representative should there be any further issues for discussion or comment in response to the Amendment or prior to any mailing of a Notice of Allowance.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



Stefan U. Koschmieder, Ph.D.
Attorney of Record
Registration No. 50,238

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 03/06)